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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,640	01/12/2000	DAVID ELLIOTT WHITTEN	HEM-98/644(H)	5923
24131	7590	12/14/2005		
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			EXAMINER DEXTER, CLARK F	
			ART UNIT	PAPER NUMBER

3724

DATE MAILED: 12/14/2005

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/481,640

Applicant(s)

WHITTEN ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3 and 10 is/are allowed.
- 6) ☒ Claim(s) 1,5,9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The amendment filed on September 19, 2005 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 5 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Halliwell, pn 1,499,106 in view of Japanese Publication 57-131670 (hereafter JP '670).

Halliwell discloses a cutting device with almost every structural limitation of the claimed invention including a rotary cutter (e.g., 7); and a transfer cylinder (e.g., 5) having a gripper (e.g., 14, 15, 16) and a tucking blade (e.g., 12) disposed in the circumferential region, and an adjustable diameter portion (e.g., 19, 20, 31, 32).

Halliwell lacks a dancer roll. However, such dancer rolls are old and well known in the art and provide various well known benefits such as moderating tension of a web or for establishing a particular tension in a web handling apparatus. JP discloses one example of such a dancer roll and teaches that it eliminates variations in tension of a web thereby to prevent breakage thereof. Therefore, it would have been obvious to one having ordinary skill in the art to provide a dancer roll on the cutting device of Halliwell for the well known benefits including those described above.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neal et al., pn 3,477,709 in view of Japanese Publication 57-131670 (hereafter JP '670).

Neal discloses a cutting device with almost every structural limitation of the claimed invention including a rotary cutter (e.g., 3); and a transfer cylinder (e.g., 2) having a circumferential region; one of a linear and eccentric jack (e.g.17, 22), and an adjustable diameter portion (e.g., 11) disposed in the circumferential region of the transfer cylinder. Neal lacks a dancer roll. However, such dancer rolls are old and well known in the art and provide various well known benefits such as moderating tension of a web or for establishing a particular tension in a web handling apparatus. JP discloses one example of such a dancer roll and teaches that it eliminates variations in tension of a web thereby to prevent breakage thereof. Therefore, it would have been obvious to

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one having ordinary skill in the art to provide a dancer roll on the cutting device of Neal for the well known benefits including those described above.

***Allowable Subject Matter***

5. Claims 2, 3 and 10 are allowable over the prior art of record.

***Request for Rejoinder of Withdrawn Claims***

6. Regarding applicant's request for rejoinder of claims 7 and 8, the Examiner's position is as follows. Claim 7 is directed to a non-elected species and includes subject matter that conflicts with the subject matter of the allowed claims. That is, a generic claim has not been allowed, and therefore claim 7 cannot be rejoined. Claim 8 may be rejoined in the form of a dependent claim. That is, a dependent claim such as the following may be added to one or more of the allowed claims, as appropriate.

-- Claim 8 (currently amended) The cutting device of claim 2, further comprising: A  
~~variable-length cutoff folder, comprising:~~

~~a rotary cutter;~~

~~a transfer cylinder configured to cooperate with said rotary cutter for cutting a ribbon into signatures having a desired cutoff length, said transfer cylinder having a central cylinder axis, a circumferential region, and an adjustable diameter portion disposed in said circumferential region of said transfer cylinder, said adjustable diameter portion connected to said transfer cylinder and being movable in a direction~~

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~~toward and away from said central cylinder axis for adjusting the desired cutoff length of the signatures;~~

~~a dancer roller for compensating for variations in length of the ribbon;~~

a jaw cylinder having a cylinder jacket and a jaw provided on said cylinder jacket,  
said tucking blade [[; and]]

~~a gripper and a tucking blade provided in said circumferential region of said transfer cylinder at a fixed distance from said cylinder axis, cooperating with said jaw for folding the signatures into said jaw, and said adjustable diameter portion being located between said gripper and said tucking blade.--.~~

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 5, 9 and 11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Remarks***

8. The Examiner acknowledges applicant's request on page 13 of the response for a telephone call. However, it is respectfully submitted that the Examiner did not have any proposed claim language to offer or to otherwise discuss with applicant and it seemed that it would be more efficient for applicant to consider the new rejections and to contact the Examiner to discuss any further amendments to the claims.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfd  
December 6, 2005